

Application Number 10/731,699  
Responsive to Office Action mailed November 1, 2006

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### REMARKS

This submission is in response to the Office Action dated November 1, 2006. Claims 1, 3-15 and 17-25 are pending.

#### Claim Rejection Under 35 U.S.C. § 102

The Office Action rejected claims 1, 3-12, 14, 18, and 21-25 under 35 U.S.C. §102(b) as being anticipated by Owens et al. (U.S. Patent No. 4,972,846).<sup>1</sup> Applicant respectfully traverses the rejection. Owens et al. fails to disclose each and every feature of the claimed invention, as required by 35 U.S.C. §102(b), and provides no teaching that would have suggested the desirability of modification to include such features.

#### *Independent Claim 1*

Owens et al. fails to teach or suggest an implantable medical device comprising at least two modules, a coupling module coupled to each of the modules, and an overmold that at least partially encapsulates each of the housings and the coupling module as recited by Applicant's claim 1.

In the rejection of claim 1 the Office Action characterizes patch electrodes 10 and 11 as being equivalent to the at least two modules recited in claim 1. The Office Action further characterizes the lead wires 21 and 23 as being equivalent to the coupling module recited in claim 1 and further characterized the silicone boot 18 as being equivalent to the overmold recited in claim 1. However, in none of these instances are the elements disclosed by Owens et al. logically equivalent to the features in Applicant's claim 1.

For example, patch electrodes 10 and 11 are not equivalent to the at least two modules because patch electrodes 10 and 11 do not each comprise one of at least two housing as recited by claim 1. If the Examiner continues to maintain the rejection of claim 1, Applicant requests the Examiner state with specificity what portion of Owens et al. teaches that patch electrodes 10 and 11 each comprise one of at least two housings.

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<sup>1</sup> Applicant notes the Examiner's apparent oversight not including claim 5 in the listing of claims rejected under 35 U.S.C. 102(b) as being anticipated by Owens et al. in the introductory paragraph of that section of the Office Action.

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As another example, even if patch electrodes 10 and 11 were considered equivalent to the at least two modules recited in claim 1, lead wires 21 and 23 can not be said equivalent to the coupling module recited in claim 1 because lead wires 21 and 23 do not define at least one lumen between the housings. To the extent that PTFE 102 could be construed to provide a lumen, the lumen of lead wire 21 is separated from the lumen lead wire 23 by generator 25. Therefore, the lumens of lead wires 21 and 23 cannot be said to be between patch electrodes 10 and 11, much less between the housings as recited by claim 1.

As another example, again for the sake of argument, even if patch electrodes 10 and 11 were considered equivalent to the at least two modules recited in claim 1, silicone boot 18 is not equivalent to an overmold as silicone boot 18 does not partially encapsulates each of the housings and the coupling module. In contrast, silicone boot 18 only partially covers paddle electrode 10 and lead wire 21. A separate silicone boot partially covers lead wire 23 and paddle electrode 11.<sup>2</sup>

Throughout the rejection of claim 1, the Office Action apparently ignores specific structures and feature recited in the claim. In order to support an anticipation rejection under 35 U.S.C. 102(b), it is well established that a prior art reference must disclose each and every element of a claim. This well known rule of law is commonly referred to as the "all-elements rule."<sup>3</sup> If a prior art reference fails to disclose any element of a claim, then rejection under 35 U.S.C. §102(b) is improper.<sup>4</sup> Clearly, the rejection of claim 1 as being anticipated by Owens et al. fails meet the standard of the all-elements rule.

### ***Independent Claims 7 and 25***

Owens et al. also clearly fails to anticipate claim 7 and 25. For example, Owens et al. fails to disclose a first module that includes control electronics comprising a first housing and a second module comprising a second housing as recited in both claims 7 and 25. As discussed

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<sup>2</sup> Owens et al., FIG. 1.

<sup>3</sup> See *Hybritech Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 231 USPQ 81 (CAFC 1986) ("it is axiomatic that for prior art to anticipate under 102 it has to meet every element of the claimed invention").

<sup>4</sup> *Id.* See also *Lewmar Marine, Inc. v. Barient, Inc.* 827 F.2d 744, 3 USPQ2d 1766 (CAFC 1987); *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (CAFC 1990); *C.R. Bard, Inc. v. MP Systems, Inc.*, 157 F.3d 1340, 48 USPQ2d 1225 (CAFC 1998); *Oney v. Ratliff*, 182 F.3d 893, 51 USPQ2d 1697 (CAFC 1999); *Apple Computer, Inc. v. Articulate Systems, Inc.*, 234 F.3d 14, 57 USPQ2d 1057 (CAFC 2000).

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with respect to claim 1, Owens et al. fails to teach that either of patch electrodes 10 and 11 comprises a housing. Owens et al. also fails to teach that either patch electrodes 10 and 11 or lead wires 21 and 23 include control electronics as recited by claim 7.

Furthermore, while the Office Action characterizes PTFE 102 as defining a lumen, PTFE 102 is clearly not a metal as recited by claim 7.

Owens et al. fails to disclose each and every limitation set forth in independent claims 1, 7 and 25. Owens et al. fails to anticipate dependent claims 1, 3-6, 8-12, 14, 18, and 21-24 for at least the reasons Owens et al. fails to anticipate independent claim 1 and 7. In view of the obvious differences between the independent claims and Owens et al., Applicant reserves further comment with respect to dependent claims 3-6, 8-12, 14, 18, and 21-24. For at least these reasons, the Office Action fails to establish anticipation of Applicant's claims 1, 3-12, 14, 18, and 21-25 under 35 U.S.C. §102(b). Withdrawal of this rejection is requested.

#### **Claim Rejection Under 35 U.S.C. § 103**

The Office Action rejected claims 13, 15, 17 and 20 under 35 U.S.C. §103(a) as being unpatentable over Owens et al., and also rejected claim 19 under 35 U.S.C. §103(a) as being unpatentable over Owens et al. in view of Kallok et al. (U.S. Patent No. 4,499,907). Applicant respectfully traverses the rejections. The applied references fail to disclose or suggest the inventions defined by Applicant's claims, and provide no teaching that would have suggested the desirability of modification to arrive at the claimed invention.

#### ***Claims 13, 15, 17 and 20***

As discussed previously with respect to independent claim 7, Owens et al. fails to teach or suggest numerous elements recited in claim 7. For example, Owens et al. fails to teach or suggest both a first module that includes control electronics comprising a first housing and a second module comprising a second housing. Owens et al. also fails to disclose a coupling module is made of a metal that defines at least one lumen between the first and second housings as recited by claim 7. Claims 13, 15, 17 and 20 are dependent on claim 7. Owens et al. fails to teach or suggest the subject matter of claims 13, 15, 17 and 20 for at least the same reasons Owens et al. fails to teach or suggest the subject matter of claim 7.

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***Claim 19***

Claim 19 is dependent on claim 7. As discussed with respect to independent claim 7, Owens et al. fails to teach or suggest both a first module that includes control electronics comprising a first housing and a second module comprising a second housing. Owens et al. also fails to disclose a coupling module is made of a metal that defines at least one lumen between the first and second housings as recited by claim 7. Kallok et al. fails to overcome these deficiencies of Owens et al. with respect to independent claim 7; therefore, Owens et al. and Kallok et al. fail to support a prima facie case for non-patentability of claim 19 under 35 U.S.C. §103(a).

For at least these reasons, the Office Action fails to establish a prima facie case for non-patentability of Applicant's claims 13, 15, 17, 19 and 20 under 35 U.S.C. 103(a). Withdrawal of this rejection is requested.

**Rejection for Obviousness-type Double Patenting**

The Office Action provisionally rejected claim 1 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of copending Application No. 10/731,638.

Applicant notes the provisional status of this rejection. Accordingly, Applicant will address this issue if and when the rejection is formally applied, i.e., when the Application No. 10/731,638 is granted.

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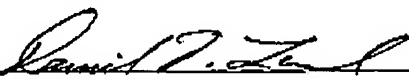
### CONCLUSION

All claims in this application are in condition for allowance. Applicant respectfully requests reconsideration and prompt allowance of all pending claims. Please charge any additional fees or credit any overpayment to deposit account number 50-1778. The Examiner is invited to telephone the below-signed attorney to discuss this application.

Date:

By:

FEBRUARY 1, 2007  
SHUMAKER & SIEFFERT, P.A.  
8425 Seasons Parkway, Suite 105  
St. Paul, Minnesota 55125  
Telephone: 651.735.1100  
Facsimile: 651.735.1102

  
Name: Daniel T. Lund  
Reg. No.: 58,614